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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,539

09/28/2004

Shigeyoshi Fujiwara

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EXAMINER

BARHAM, BETHANY P

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/509,539	Applicant(s) FUJIWARA ET AL.	
	Examiner Bethany P. Barham	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) 7-8, 10-11, 13-14 and 16-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/28/2004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Summary

Receipt of IDS filed on 09/28/2004 is acknowledged. Claims 1-17 are pending.

Claims 1-17 are rejected.

OBJECTIONS

Claims 7-8 and 13-14 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 10-11 and 16-17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-6 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-6 and 9-11 of copending Application No. 10/471,087. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a barium sulfate powder that can be doped with Zn, Li or Na.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 10-11 and 16-17 provide for the use of the powder, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10-11 and 16-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an

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improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06-009359 ('359).

The limitations of claims 1, and 7-11 are taught:

- '359 teaches fine particles used in the field of cosmetics or skin external preparations such as silica, titanium dioxide, talc and barium sulfate, and that these particles can be used independently, or together as two or more [0008] and that the F-potential of the fine particles was (-) [0032].

Claims 1, 3, and 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,416,573 B2 ('573).

The limitations of claims 1, 3, and 7-11 are taught:

- '573 teaches a powder, which augments the hiding of troubled morphology of the skin and troubled skin tone and has a good feel (smoothness) when used in cosmetics (col. 4, lines 27-42). '573 teaches that the composite pigment of the powder can be a clay mineral, barium sulfate, or pearl pigments of a particle size of 0.2-50 microns (col. 9, lines 20-51). '573 teaches that the structure of the pigment can be tabular with a flat surface (col. 9, lines 52-53). '573 teaches including other ingredients besides the composite pigment, such as talc, kaolin, mica, barium sulfate, etc. (col. 17, lines 35-67).
- '573 teaches that the powders or composite pigments at a usage range of 1-100% by weight and are further present in the amount of 1-30% by weight in emulsification cosmetics and 1-80% by weight in solid powder cosmetics (col. 8, lines 33-44).
- It is the examiners opinion that the powder provides a barrier to the skin and prevents a roughening of the skin since it is described as hiding skin morphology and providing smoothness.

Claims 2, 4, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by CA 2,374,539 A1 ('539).

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The limitations of claims 2, 4, 12 and 15 are taught:

- '539 teaches an anti-corrosive agent comprising a conductivity pigment such as doped barium sulfate of 0.0005 to 5 microns in diameter in the amount of 1-30% by weight (claims 1, 5-7), the barium sulfate being doped with tin or antimony (pg. 12, lines 43-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,416,573 B2 ('573) in view of JP 11-130652 ('652).

The limitations of claims 1, 3, and 7-11 are taught:

- '573 is taught above.
- '573 does not specifically state "skin barrier function" or "skin roughening preventing and improving powder".
- '652 teaches that a skin cosmetic containing clay minerals having a >30mV absolute value of zeta potential and a particle diameter of 1-5000nm is capable of having excellent skin protecting effects and improving effects on chapped skin and moisture retaining ability (abstract and claim 1). '652 teaches that these clay

materials are effective in providing a skin barrier [0010-0011]. '652 teaches that numerous clay minerals are blended in the skin cosmetic smectite, bentonite, montmorillonite, beidellite, nontronite, saponite, etc [0016]. The clay is present in an amount of 0.1 to 10% by weight [0021].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine '573 and '652, since both teach cosmetics comprising mineral pigments. '573 teaches clay, barium sulfate and pearl pigments are capable of being used for a smooth powder or emulsion, while '652 teaches various mineral including clay. One of ordinary skill in the art would look to '652 which teaches that various clays and minerals are known to impart skin protecting effects and improving effects as well as a skin barrier, in order to make the composition of '573 with barium sulfate, with a reasonable expectation of success.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bethany Barham whose telephone number is (571)-272-6175. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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